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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,793	12/12/2001	Stephen Ray Wurzburger	RSSW13	3436

7590 12/19/2005

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EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,793

Applicant(s)

WURZBURGER, STEPHEN RAY

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-13 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-13 and 23-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of amendments filed on September 20, 2005. Claims 7-13 and 23-28 are pending. Claim rejections made under 35 U.S.C. § 112 are withdrawn in view of claim amendments made by applicants. Claim rejection made under 35 U.S.C. § 103 (a) is withdrawn in view of the claim amendments, and new rejections are made.

Response to Amendment

The amendment filed September 20, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

In Amendment in the Specification, page 2, line 6, "pH range (2.65)" is new. The original specification states "pH rage (2.5)".

The inserted statements in lines 8-10 are new and unsupported by original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

Claim 28 is objected to because of the following informalities: lines 12-13 contain typographical error in reciting "from a group". Appropriate correction is required.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 7-13, 23-25, 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wurzburger et al. (WO 00/56157) in view of Wachman et al. (US 5407949) and Beerse et al. (US 6294186 B1).

Wurzburger et al. teach disinfecting solution having not more than 2500 ppm of calcium sulfate and pH less than 2.5, wherein the solution is made by filtering the insoluble salts of sulfuric acid and calcium hydride. See p. 3 and p. 8. See instant claims 7 and 11. The pH is said to remain stable for longer than 48 hours. The reference teaches that the disinfecting agent is topically used to clean hands, to treat athlete's foot, burns, insect bites and wounds, and is harmless to the skin. See p. 8, lines 6 – 18.

Wurzburger et al. fail to teach the pH of less than 1.5, and the additives of the claimed invention.

Wachman et al. teach sterilizing solution for medical and dental devices, wherein the composition comprises metal salts, quaternary ammonium compounds, isopropanol, metal chelator, and carrier. See Examples; instant claims 8 and 12. The reference teaches using up to 0.25 % of a chelator, wherein oxalic acid is a useful chelating agent. See col. 8, lines 53 – 66. See instant claim 10. The reference teaches that alkylbenzyltrimethyl ammonium chloride is particularly preferred and used in the amount of 0.05-3 % by weight. See col. 6, lines 55 – 63; instant claims 12 and 13.

Beerse et al. teach topical antimicrobial composition having a benzoic acid analog and a metal salt, wherein the composition has pH of about 1- about 7, more preferably about 1.5 – about 5. See col. 19, lines 35 – 50. The reference teaches, “an

acidic environment protonates the viral capsid shell, which initiates a conformational change that irreversibly inactivates the virus, rendering the virus incapable of initiating infection. This effect synergizes with the metal salt and acid structure to produce the desired immediate and residual anti-viral and anti-bacterial efficacy which is key to the present composition". As for the metal salts, the reference teaches using the salts of copper, iron, silver, and tin; and of phosphates, iodide, nitrates, chloride, and acetates. See col., 7, lines 1-59. See instant claim 28. Making a film-forming composition by adding film-forming polymer to add substantivity is also well known in the art. See col. 19, line 57 – col. 20, line 15. The release of the active ingredients from the carrier into the skin is viewed the resulting property of the composition. The reference also teaches adding fragrances, and using eucalyptus oil is also suggested. See col. 20, lines 30-5. See instant claims 25 and 27. The reference teaches that the most preferred carrier is in the form of alcohol, preferably ethanol or isopropanol. See col. 9, line 32 – 54. The reference further teaches adding lipophilic moisturizing agents, including mineral oil. See col. 10, lines 43 – 46; instant claim 23. Using glycerine as a moisturizing agent is also preferred. See col. 18, lines 54 – 58. See instant claim 24. The reference also teaches using lactic acid or its salts as a skin conditioning agent, in the amount of 0.01-20 % by weight. See col. 36, lines 15 – 24. See instant claim 9.

It would have been obvious to one of ordinary skill in the art at the time the present invention was made to have modified the composition of Wurzbarger et al. by combining the additives of Wachman et al. The idea for combining compounds each of which is known to be useful for the same purpose, in order to form a composition which

is to be used for the same purpose, flows logically from their having been used individually in the prior art. See In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). As shown by the recited teachings, the instant claims define nothing more than the concomitant use of conventional disinfecting agents for pharmaceutical and medical use. It would follow that the recited claims define prima facie obvious subject matter.

It would have been also obvious to the skilled artisan to further modify the disinfecting composition by lowering the pH to below 1.5, as motivated Beerse et al., because 1) Wurzburger et al. teach disinfecting solution having pH below 2.0; and 2) Beerse et al. teach dermatologically acceptable antimicrobial composition having pH of as low as 1 and about 1.5, and teaches that the acidic composition affectively provides enhanced antiviral and antimicrobial effects. The skilled artisan would have had a reasonable expectation of successfully producing a dermatologically acceptable acidic composition with improved disinfecting properties by combining the teachings of the references.

Claim 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wurzburger et al. Wachman et al., and Beerse et al., as applied to claims 7-13, 23-25, 27, and 28 as above, and further in view of Flick (Cosmetic and Toiletry Formulations).

While Beerse teaches using fragrances in topical antimicrobial composition, the reference does not specifically mention vanilla extract.

Flick teaches that it is well known to use vanilla extract in topical compositions.
See p. 95.

As stated in the previous Office action, fragrance is a conventional ingredient commonly used in personal care products. In support of the previous rejection, Flick is cited to show that it is obvious that a skilled artisan would have been motivated to use vanilla extract to make the disinfecting solution more cosmetically appealing to consumers.

Response to Arguments

Applicant's arguments with respect to claims 7-13, 23-28 have been considered but are moot in view of the new ground(s) of rejection in part and unpersuasive in part.

Applicant's argument that the lowest pH value of microwater is 2.7 is moot, as the amendment to the specification filed on September 20, 2005, is considered a new matter not supported by the original disclosure. Furthermore, applicant also relies on information that is not made record in this case. The information and confirmation obtained from Bernd Friedlander are hearsay and thus has not been considered by the examiner. Nevertheless, applicant's arguments are moot in view of the new grounds of rejection which is prompted by the claim amendments made by applicants, as discussed above.

In response to applicant's argument that applicant adds quaternary amine to activated water to perform a different function than taught by Wachman, examiner notes that the claimed invention is a composition which merely requires an aqueous solution having a pH of less than 1.5 and the presence of the recited ingredients. A chemical

composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Furthermore, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, since the prior arts teach that it would have been obvious to make the disinfection composition comprising quaternary amine and pH of about 1, the alleged "hygroscopic nature" of quaternary amine would naturally be found by combining the teachings of the references. It is also noted that there is no requirement that the "activated water" is used.

In response to applicant's argument that Wachman is not for topical use, it is respectfully noted that the Wachman antimicrobial composition actually is used to disinfect medical and dental equipments that makes a direct human contact, such as catheters, dialysis machine tubing, anesthetic breathing bags, surgical instruments, dental bite blocks. It is obvious that the Wachman composition must be **particularly** safe to human. Furthermore, the primary reference Wurzbarger teaches a disinfectant agent which has a wide range of application including pharmaceutical topical use, household use, disinfecting utensils and cutting board, which suggests that the use of the claimed disinfectant is not limited to one particularly application.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

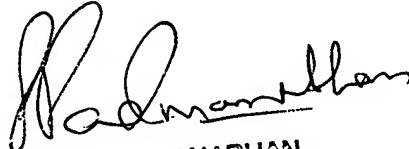
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. ~~In the event a first reply is filed within~~ **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 7:00AM until 4:30 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner



STEEN PADMANABHAN
SUPERVISORY PATENT EXAMINER